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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,302	12/29/2000	Andrew Rouse	042846-0312814	6724

52796 7590 12/21/2010

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EXAMINER	
COULTER, KENNETH R	

ART UNIT	PAPER NUMBER
2445	

MAIL DATE	DELIVERY MODE
12/21/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/750,302	ROUSE ET AL.	
	Examiner	Art Unit	
	Kenneth R. Coulter	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 November 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 21 – 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 28 of U.S. Patent No. 7,142,883 (U.S. Pat. Application No. 09/885,139). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim language of the present Application (claims 21 – 40 of 09/750,302) is a broad version of the claims of U.S. Patent No. 7,142,883 (claims 1 - 28).

Claim 21 in the present Application is a broad version of claim 1 in 7,142,883.

Claim 22 in the present Application maps exactly to claim 4 in '883.

Claim 23 in the present Application maps closely to claim 5 in '883.

Claim 24 in the present Application maps very closely to claim 7 in '883.

Claim 25 in the present Application maps closely to a portion of claim 1 in '883 (claim 1 "generating a mobile design element based on the accessed form …").

Claims 26 – 40 are mapped similarly to the explanations given above.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 21 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahan et al. (U.S. Pat. Pub. No. 2002/0024536) (Method and Apparatus for Information Aggregation and Personalized Display of the Aggregated Information).

4.1 Regarding claim 21, Kahan discloses a method of formatting content for display on a mobile wireless client device that is based on a form that is used to display content on a desktop computer, the form being associated with an action that is executable by an application, wherein the form is stored remotely from the mobile wireless client device, the method comprising:

receiving at a server from the mobile wireless client device, via a wireless medium, the selection of an action made by a user at an interface of the mobile wireless client device (Abstract; Figs. 6, 8; paragraph 70 (see below); paragraphs 51, 53, 115, 116);

paragraph 70 of Kahan

The control process 22 also supports *subscriber manipulations*. For a **content item** that has a **specific action menu** associated with it, when the subscriber selects the content item, the subscriber will view the detailed data attached to the content item (associating a content item with a generic menu or a specific action menu will be described below). In addition, the subscriber will receive a list of specific actions as proscribed by the outside applications. The control process 22 builds a screen of **content items to present to the subscriber** using the data items transmitted (i.e., pushed) from the outside applications. Should the **subscriber select one of the specific actions associated with a content item**, the control process 22 transmits the selected action to an application link that actually handles the selected action (e.g., sell a particular stock) without any further involvement from the control process 22.

executing the action at the server remotely from the mobile wireless client device, wherein executing the action generates content (Fig. 4, item 22; paragraph 70 (see above));

providing a user-customized mobile design element that corresponds to the form and is associated with the mobile wireless client device, and has been customized by the user of the mobile wireless client device (Abstract; Fig. 6; Figs. 3, 4; paragraph 70 (see above); paragraphs 71 – 78 (see below));

paragraphs 71 – 78 of Kahan

If a generic menu is associated with the selected content item, the control process 22 presents the identical set of generic actions to the subscriber. Recall that the subscriber interfaces with the control process 22 through the WML pages 28 or the HTMLXL pages 29 located on the web server 27. At a minimum, the control process 22 supports the following generic actions:

1. Forward--the **subscriber selects this action** to forward a content item to a name entered in a personal address book or entered from the mobile terminal.

2. Keep, Delete--the **subscriber selects one of these actions** to temporarily remove a content item from the mobile portal home page (delete), or to keep it there (keep).

3. Push to Top, Remove, Modify this Line--the **subscriber selects one of these actions** to permanently modify the appearance (i.e., content item positioning) of the mobile portal home page.

4. Voice--the **subscriber selects this action** to execute a text to speech conversion of the content item's text.

5. Go to Application--The **subscriber selects this action** to execute an outside application.

6. Go to Home Page--The **subscriber selects this action** to return to the mobile portal home page.

The foregoing list of generic actions is exemplary in nature and should not be interpreted as limiting in any way.

formatting the content according to the mobile design element (Abstract (see below); Fig. 3; paragraph 14 (see below));

Abstract of Kahan

A method and apparatus for aggregating data items to be sent to a mobile terminal subscriber. A plurality of data items are received from content providers and a subscriber provisioning profile is used to select out desired data items for display on a mobile terminal or a client terminal. **The subscriber provisioning profile contains the mobile terminal subscriber's preferences with regard to the data items, and**

the data items are formatted for display according to the mobile terminal subscriber's provisioning profile. The formatted data items are transmitted to the mobile terminal subscriber's terminal for viewing by the subscriber.

Paragraphs 14 of Kahan

According to a fifth aspect of the present invention, a mobile portal server that aggregates content to be transmitted to a terminal subscriber is provided. The **mobile portal server comprises a subscriber database that stores a provisioning profile for the terminal subscribers, and an applications interface processor that receives data items from one or more outside applications and adapts the data items into formatted data items for transmission to mobile terminals** or client terminals associated with the terminal subscribers. The data items are formatted according to a provisioning profile stored on the subscriber database. The mobile portal server further comprises a web server that provides access to the formatted data items, and a control processor connected to the applications interface processor, the subscriber database and the web server.

transmitting, via the wireless medium, the content that is formatted according to the mobile design element to the mobile wireless client device (Abstract (see above); Figs. 3, 4; paragraph 14 (see above)); and

storing the mobile design element remotely from the mobile wireless client device for future access by the server (Fig. 3, items 25 and 44; paragraph 14 (see above), paragraph 58 (see below), paragraph 66).

Paragraph 58 of Kahan

For example, a financial services application executing on an applications server at a brokerage house could provide data items regarding the current value of a brokerage account, stock prices, bond prices, interest rates, currency exchange information and other financial information. **If a subscriber was interested in receiving certain data**

items from the set of data items provided by the financial services application, those selected data items are entered into the subscriber's provisioning profile 44, which is stored on the subscriber database 25. Of course, the subscriber's provisioning profile 44 can include requests for data items from a variety of outside applications servers 17-19 (e.g., world news items, sports news, weather updates, personal email server, personal calendar, etc.). There is no limitation on the variety or type of data items that can be listed in a subscriber provisioning profile 44.

4.2 Per claim 22, Kahan teaches the method of claim 21, wherein the mobile design element comprises one or more of a document style sheet, a view style sheet, a pre-formatted page, or a script (Figs. 5, 7; paragraphs 52, 59).

4.3 Regarding claim 23, Kahan discloses the method of claim 21, wherein the customization of the mobile design element by the user impacts one or both of the type of information included in the content and/or the visual layout of the content (Abstract; Fig. 6, item 62; paragraphs 51, 53).

4.4 Per claim 24, Kahan teaches the method of claim 21, wherein the customization of the mobile design element by the user includes a customization of one or more of a date/time setting, a language setting, a field size setting, a content size setting, and a mobile design element size setting (paragraph 52).

4.5 Regarding claim 25, Kahan discloses the method of claim 21, further comprising:

receiving a customization input from the user to customize the mobile design element based on the form (Abstract; paragraph 115).

4.6 Per claims 26 – 40, the rejection of claims 21 – 25 under 35 USC 102(e) (paragraphs 4.1 – 4.5 above) applies fully.

5. Claims 21 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis (U.S. Pat. No. 6,076,109) (Simplified-File Hyper Text Protocol).

5.1 Regarding claim 21, Kikinis discloses a method of formatting content for display on a mobile wireless client device that is based on a form that is used to display content on a desktop computer, the form being associated with an action that is executable by an application, wherein the form is stored remotely from the mobile wireless client device, the method comprising:

receiving at a server from the mobile wireless client device, via a wireless medium, the selection of an action made by a user at an interface of the mobile wireless client device (Abstract; Fig. 3; col. 6, lines 48 – 59; col. 9, lines 26 - 41);

executing the action at the server remotely from the mobile wireless client device, wherein executing the action generates content (Abstract; Figs. 2 – 4; col. 10, lines 36 – 45);

providing a user-customized mobile design element that corresponds to the form and is associated with the mobile wireless client device, and has been customized by the user of the mobile wireless client device (Abstract; Figs. 2 – 4; col. 9, lines 55 – 58 “At step 61 the **user logs on by entering a user name and password** and the field

unit identifies itself with its ID."; col. 10, lines 5 – 36 "Proxy-Server converts all of the .jpg files to a dithered bitmap format according to information associated with the **user ID received from the hand-held** at log-on. **This ID establishes the size and resolution of the hand-held's display, for example, and the bitmap created from the .jpg files is scaled to the hand-held's display**.");

formatting the content according to the mobile design element (Abstract; Figs. 3, 4; col. 10, lines 5 – 36 "Proxy-Server converts all of the .jpg files to a dithered bitmap format according to information associated with the **user ID received from the hand-held** at log-on. **This ID establishes the size and resolution of the hand-held's display, for example, and the bitmap created from the .jpg files is scaled to the hand-held's display**.");

transmitting, via the wireless medium, the content that is formatted according to the mobile design element to the mobile wireless client device (Abstract; Figs. 3, 4; col. 10, lines 37 – 46 "the proxy server assembles all of these files into a single HT-Lite (HTL) file for **transfer to the hand-held**"); and

storing the mobile design element remotely from the mobile wireless client device for future access by the server (Abstract; Figs. 3, 4; col. 10, lines 31 – 36; col. 9, lines 7 - 41).

5.2 Per claim 22, Kikinis teaches the method of claim 21, wherein the mobile design element comprises one or more of a document style sheet, a view style sheet, a pre-formatted page, or a **script** (col. 9, lines 7 - 13).

5.3 Regarding claim 23, Kikinis discloses the method of claim 21, wherein the customization of the mobile design element by the user impacts one or both of the type of information included in the content and/or the visual layout of the content (Figs. 3, 4; col. 9, lines 55 – 58; col. 10, lines 30 – 35).

5.4 Per claim 24, Kikinis teaches the method of claim 21, wherein the customization of the mobile design element by the user includes a customization of one or more of a date/time setting, a language setting, a field size setting, a content size setting, and a mobile design element size setting (Fig. 3, item 101; col. 10, lines 30 - 35).

5.5 Regarding claim 25, Kikinis discloses the method of claim 21, further comprising:

receiving a customization input from the user to customize the mobile design element based on the form (Figs. 3, 4; col. 9, lines 55 – 58; col. 10, lines 30 – 35).

5.6 Per claims 26 – 40, the rejection of claims 21 – 25 under 35 USC 102(e) (paragraphs 5.1 – 5.5 above) applies fully.

Response to Arguments

Applicant's arguments filed 11/29/10 have been fully considered but they are not persuasive.

With regard to the rejection of claims 21 – 40 under obviousness-type double patenting with respect to claims 1 – 28 of U.S. Patent No. 7,142,883:
Applicant has presented no arguments.

With regard to the rejection of claims 21 – 40 under 35 USC 102(e) with respect to Kahan et al. (U.S. Pat. Pub. No. 2002/0024536):
Applicant argues that that Kahan reference "does not constitute prior art under 102(e) at least because the filing data of the present application precedes the filing date of Kahan." (p. 9, paragraph 1 of Arguments on 10/29/10)
Examiner has relied upon the filing date of U.S. Provisional Application No. 60/227,852.
Applicant argues that the Provisional Application of Kahan (60/227,852), on which Kahan '536 claims priority, "does not include all of the subject matter disclosed in Kahan, including some of the subject matter relied on by the Examiner in the rejection of claims 21-40."
Applicant does not specifically point out which subject matter relied upon in Kahan '536 that is absent in Kahan '852.

With regard to the rejection of claims 21 – 40 under 35 USC 102(e) with respect to Kikinis (U.S. Pat. No. 6,076,109):

Applicant argues that Kikinis fails to disclose these features at least because (1) there is no disclosure of wireless communication in the cited sections of Kikinis, and (2) Kikinis does not disclose user-customization of a 'mobile design element' as recited in claim 1." (p. 9, last paragraph of Arguments on 10/29/10).

Examiner disagrees.

Kikinis clearly discloses wireless communication (Abstract "portable, battery-powered computers"; col. 3, lines 1 – 6 "**Various data links known in the art may be used** for coupling field computers, such as batter-powered portable units, to a Proxy-Server … **cordless connections** of various types.")

Kikinis clearly teaches "providing a user-customized mobile design element that corresponds to the form, is associated with the mobile wireless client device, and has been customized by the user of the mobile wireless client device."

As taught in the rejection above, Kikinis discloses a user ID entered by the user (col. 9, lines 55 – 58) and sent to the Proxy-Server, wherein this ID "establishes the size and resolution of the hand-held's display …" (col. 10, lines 30 – 35).

Kikinis discloses a user ID entered by the user (col. 9, lines 55 – 58) and sent to the Proxy-Server, wherein this ID "establishes the size and resolution of the hand-held's display …" (col. 10, lines 30 – 35). The settings are automatically selected when the user enters the ID, thereby customizing any forms since the ID "establishes the size and resolution of the hand-held's display …".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell can be reached on 571 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2445

/KRC/